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| Typed or Printed Name   | Cindy Hoang  |                           |
| Signature   | Date November 5, 2001  |                           |
| <b>RESPONSE TO RESTRICTION REQUIREMENT</b><br><br>Address to:<br>Commissioner for Patents<br>Washington, D.C. 20231<br><br><i>Duplicate<br/>Pages</i> | Attorney Docket (Confirmation No.)                             | UCAL138<br>To Be Assigned |
|   | First Named Inventor   | ROSEN                     |
|   | Application Number   | 09/593,828                |
|   | Filing Date  | June 13, 2000             |
|   | Group Art Unit   | 1652                      |
|   | Examiner Name  | M. Monshipouri            |
|   | Title: NOVEL GLYCOSYL SULFOTRANSFERASES GST-4A, GST-4B & GST-6 |                           |

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TECH CENTER 1600/2900

Sir:

This is in response to the Office Action dated August 9, 2001, and is further responsive to the Restriction Requirement and Species Election Requirement dated May 9, 2001. A three-month period was set for responding to the Office Action, making this response due November 9, 2001. Accordingly, this response is timely filed.

## SPECIES ELECTION REQUIREMENT

The Examiner required election of one of the following species, as set forth in the Office Action dated May 9, 2001: GST-4 $\alpha$ ; GST-4 $\beta$ ; and GST-6.

Applicants hereby elect the species GST-4 $\alpha$ . The Office Action stated that claims 1-29 are generic.

This species election is made with traverse.

As stated in 37 C.F.R. §1.141, more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim.

Applicants submit that the claims are directed to a reasonable number of species. Accordingly, Applicants submit that the species election requirement is not proper.

Applicants expressly reserve the right under 35 USC §121 to file one or more divisional applications directed to the non-elected species during the pendency of this application.

With respect to election of species, Applicants respectfully request rejoinder of withdrawn species claims upon allowance of a claim that encompasses the currently withdrawn species.

#### **RESPONSE TO RESTRICTION REQUIREMENT**

In the Restriction Requirement dated May 9, 2001, the Examiner required election of one of the following groups of claims:

- Group I: Claims 1-4, drawn to a glycosyl sulfotransferase and fragments;
- Group II: Claims 5-12, drawn to nucleic acid sequences encoding glycosyl sulfotransferase, expression cassettes and cells comprising the sequences and methods of expressing the sequences;
- Group III: Claims 13-15, drawn to antibodies that specifically bind the sulfotransferase;
- Group IV: Claims 16-22, drawn to a method of inhibiting a binding event between a selectin and its ligand;
- Group V: Claims 23-24, drawn to a method of modulating a symptom in a mammal with a condition related with a selectin mediated binding event;
- Group VI: Claims 25-27, drawn to a method of diagnosing a disease; and
- Group VII: Claim 29, drawn to a non-human transgenic animal.

As noted in the response, filed June 1, 2001, to the May 9, 2001 Office Action, Applicants elect to prosecute the claims of Group II, claims 5-12 with traverse. As stated in the MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. It is Applicants' position that it would not be unduly burdensome to perform a search on claims 1-29 together. Accordingly, Applicants traverse the restriction requirement.

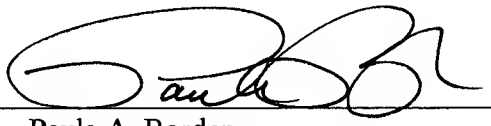
Applicants expressly reserve the right under 35 USC §121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.

CONCLUSION

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number UCAL138.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: Nov. 5, 2001

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